

PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:
ANNA M. VRADENBURGH
BRULL PICCIONELLI SARNO BRAUN
& VRADENBURGH
1925 CENTURY PARK EAST, SUITE 2350
LOS ANGELES, CA 90067

PCT

NOTIFICATION OF TRANSMITTAL OF INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Rule 71.1)

Date of Mailing
(day/month/year)

25 MAR 2003

Applicant's or agent's file reference

63033.801WO0

IMPORTANT NOTIFICATION

International application No.

PCT/US01/25481

International filing date (day/month/year)

15 August 2001 (15.08.2001)

Priority date (day/month/year)

01 September 2000 (01.09.2000)

Applicant

SEARCH123.COM, INC.

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary examination report and its annexes, if any, established on the international application.
2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.
4. **REMINDER**

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices)(Article 39(1))(see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary examination report. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the PCT Applicant's Guide.

Name and mailing address of the IPEA/US
Commissioner of Patents and Trademarks
Box PCT
Washington, D.C. 20231

Facsimile No. (703)305-3230

Authorized officer

Heather R Herndon

Telephone No. 703-305-9000

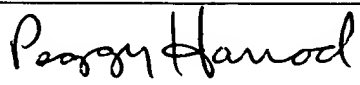
Peggy Herndon

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference 63033.801WO0	FOR FURTHER ACTION		See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)
International application No. PCT/US01/25481	International filing date (day/month/year) 15 August 2001 (15.08.2001)	Priority date (day/month/year) 01 September 2000 (01.09.2000)	
International Patent Classification (IPC) or national classification and IPC IPC(7): G06F 15/00 and US Cl.: 715/501			
Applicant SEARCH123.COM, INC.			
<p>1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of <u>5</u> sheets, including this cover sheet.</p> <p><input type="checkbox"/> This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).</p> <p>These annexes consist of a total of <u>0</u> sheets.</p>			
<p>3. This report contains indications relating to the following items:</p> <ul style="list-style-type: none"> I <input checked="" type="checkbox"/> Basis of the report II <input type="checkbox"/> Priority III <input type="checkbox"/> Non-establishment of report with regard to novelty, inventive step and industrial applicability IV <input type="checkbox"/> Lack of unity of invention V <input checked="" type="checkbox"/> Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement VI <input type="checkbox"/> Certain documents cited VII <input type="checkbox"/> Certain defects in the international application VIII <input type="checkbox"/> Certain observations on the international application 			
Date of submission of the demand 28 March 2002 (28.03.2002)		Date of completion of this report 06 March 2003 (06.03.2003)	
Name and mailing address of the IPEA/US Commissioner of Patents and Trademarks Box PCT Washington, D.C. 20231 Facsimile No. (703)305-3230		Authorized officer Heather R Herndon  Telephone No. 703-305-9000	

I. Basis of the report

1. With regard to the elements of the international application:*

- ☒ the international application as originally filed.
- ☒ the description:
pages 1-48 _____ as originally filed
pages NONE _____, filed with the demand
pages NONE _____, filed with the letter of _____.
- ☒ the claims:
pages 49 _____, as originally filed
pages NONE _____, as amended (together with any statement) under Article 19
pages NONE _____, filed with the demand
pages NONE _____, filed with the letter of _____.
- ☒ the drawings:
pages 1-14 _____, as originally filed
pages NONE _____, filed with the demand
pages NONE _____, filed with the letter of _____.
- ☐ the sequence listing part of the description:
pages NONE _____, as originally filed
pages NONE _____, filed with the demand
pages NONE _____, filed with the letter of _____.

2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language _____ which is:

- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).

3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in printed form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages NONE
- ☐ the claims, Nos. NONE
- ☐ the drawings, sheets/fig NONE

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).**

* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17).

** Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.
PCT/US01/25481

V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. STATEMENT

Novelty (N)	Claims <u>1-5</u>	YES
	Claims <u>NONE</u>	NO
Inventive Step (IS)	Claims <u>NONE</u>	YES
	Claims <u>1-5</u>	NO
Industrial Applicability (IA)	Claims <u>1-5</u>	YES
	Claims <u>NONE</u>	NO

2. CITATIONS AND EXPLANATIONS

Please See Continuation Sheet

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.
PCT/US01/25481**Supplemental Box**

(To be used when the space in any of the preceding boxes is not sufficient)

Claims 1-5 lack an inventive step under PCT Article 33(3) as being obvious over in view of Skillen et al., US 6,098,065 issued 08/2000 in view of Golhaber et al., US 5,855,008 issued 12/1998.

Regarding independent claim 1, Skillen teaches the steps of:

receiving a search criterion from a customer for producing search results (Skillen, col.1, lines 40-42);

obtaining and transmitting the search results to the customer (Skillen, col.4, lines 8-11); and

transmitting to the customer invitations related to the search criterion (Skillen, col.1, lines 44-49, sending the search results together with advertisements which relate to the search criterion).

However, Skillen does not explicitly disclose that transmitting to the customer an advertisement to be included in the target list related to the search criterion.

Golhaber teaches transmitting to the customer an advertisement to be included in a target list (Golhaber, col.3, lines 17-20 and col.12, lines 49-60, the user accepts the invitation by clicking on an advertisement to be included in a list of consumer interest profile).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Skillen and Golhaber to provide more information based on user interest by using "targeted direct mailings", since user's name and email address are put in consumer interest profile.

Regarding dependent claim 2, which is dependent on claim 1, Skillen and Golhaber teach the limitations as explained in claim 1 above. Refer to the rationale relied to reject claim 1, the step of "receiving from the customer an acceptance of the invitation to be included in the target list, the acceptance including contact information for the customer" is addressed. The rationale is incorporated herein.

Claims 2 and 4 lack an inventive step under PCT Article 33(3) as being obvious over the prior art as applied in the immediately preceding paragraph and further in view of Kamakura et al., US 6,047,310 issued 04/2000.

Regarding dependent claim 3, which is dependent on claim 2, Skillen and Golhaber teach the limitations as explained in claim 2 above. Skillen does not explicitly disclose the step of transmitting a confirmation request using the contact information.

Kamakura teaches the step of transmitting a confirmation request using the contact information (Kamakura, col.6, line 56 - col.7, line 3).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have incorporated Kamakura into Skillen and Golhaber to provide a authentication of the accepting, since the confirmation request is sent to the user's email address.

Regarding dependent claim 4, which is dependent on claim 3, Skillen, Golhaber, and Kamakura teach the limitations as explained in claim 3 above. Kamakura further teaches the step of receiving a confirmation of the acceptance from the customer (Kamakura, col.6,

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.
PCT/US01/25481

Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

line 56 - col.7, line 3).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have incorporated Kamakura into Skillen and Golhaber to provide a verification of the accepting, since the user sends back the confirmation.

Regarding dependent claim 5, which is dependent on claim 4, Skillen, Golhaber, and Kamakura teach the limitations as explained in claim 4 above. The combination of Skillen and Golhaber teach adding the contact information to the target list that is related to the search result as explained in claim 1 above. Skillen further teaches, "as user interact with the advertising system, it will continue to compile preference data (e.g. a list of keywords for each user" (Skillen, col.2, lines 44-46).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Skillen and Golhaber to adding the contact information to the target list related to the keyword, since it would have enhanced the organization of user profile.

----- NEW CITATIONS -----

US 6,098,065 (SKILLEN et al.) 01 August 2000, see col.1, lines 40-49; col.2, lines 44-46; and col. 4, lines 8-11.

US 5,855,008 (GOLDHABER et al.) 29 December 1998, see col.3, lines 17-20; col.5, lines 12-16; col.12, lines 49-60.

US 6,047,310 (KAMAKURA et al.) 04 April 2000, see col.6, line 63 - col.7, line 3.